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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,686	03/29/2001	Hiroshi Hanzawa	24582	3152

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,686

Applicant(s)

HANZAWA ET AL.

Examiner

Bradley Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/29/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 23-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-22 are presented for examination.

Election/Restrictions

Applicant's election without traverse of claims 23-27 over the telephone by applicant's representative (Derek Richmond) on December 9, 2003 is acknowledged.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copies were received in paper numbers 2 and 3 and filed on 3/29/2001 and 5/17/2001, respectively.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 3-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 3 merely recites an abstract idea without claiming any use of technological arts. The mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps/elements or structural relationship between such elements, such omission amounting to a gap between the steps/elements. See MPEP § 2172.01.

The omitted steps/elements are for instance: In claims 1 and 3 for example, applicant states, “wherein said literary work information includes management information for controlling a print processing...” However, the applicant does not specify the elements/steps or structural relationship between such steps in achieving the claimed invention. The preceding is provided by way of example, therefore, the applicant should provide all essential steps/elements and structural relationship between the elements in claiming its invention.

Claim Rejections - 35 USC § 102

Art Unit: 3621

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 and 13-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik et al, U.S. Patent 6,236,971 B1 (hereinafter Stefik).

As per claims:

1. An accounting printing system for printing literary work information in a digital form, wherein said literary work information includes management information for controlling a print processing of said literary work information, and said literary work information is printed based under print conditions specified in said management information (figure 15 and associated text; column 4, lines 5-50; columns 24-26).
2. The accounting printing system according to claim 1, wherein said management information controls upper and lower limit numbers of pages to be printed of said literary work information (columns 10-11).
3. An accounting printing method for printing literary work information in a digital form, wherein said literary work information includes management information for controlling a print processing of said literary work information, and said literary work information is printed under

print conditions specified in said management information (figure 4a, 15 and associated text; column 4, lines 5-50; columns 24-26).

4. The accounting printing method according to claim 3, wherein said management information controls upper and lower limit numbers of pages to be printed of said literary work information (columns 10-11).

5. An accounting printing system comprising: an information distributing apparatus for distributing literary work information in a digital form and management information for controlling a print processing of said literary work information; and a printing apparatus which is connected to said information distributing apparatus through an electronic network, receives and stores said literary work information and said management information, and prints said literary work information under print conditions specified in said management information (figure 4a, 15 and associated text; column 4, lines 5-50; columns 24-26).

6. The accounting printing system according to claim 5, wherein said printing apparatus includes: a user information storing section for storing information on a user who utilizes said printing apparatus (figure 13 and associated text); an authentication processing section for executing authentication of a user who wants the print processing of said literary work information based on said information on said user (figures 16-17 and associated text); a controlling section for controlling the print processing of said literary work information by an authenticated user based on said information on said user and said management information

(figures 4a-b and associated text); and a print processing section for printing said literary work information in accordance with a command from said controlling section (figure 14 and 18 and associated text).

7. The accounting printing system according to claim 5, wherein said management information controls upper and lower limit numbers of pages to be printed of said literary work information (columns 10-11).

8. The accounting printing system according to claim 6, wherein said printing apparatus further includes an aggregating section for aggregating and outputting a printing fee of said literary work information (figure 18 and associated text; columns 24-26).

9. The accounting printing system according to claim 8, wherein said aggregating section periodically outputs a aggregation result of the printing fee of said literary work information to said information distributing apparatus and, when the amount of the aggregation result reaches more than a predetermined amount, said controlling section controls said print processing section not to execute the print processing of said literary work information (figure 3, 4b, and 18 and associated text).

10. The accounting printing system according to claim 6, wherein said printing apparatus periodically communicates with said information distributing apparatus through the electronic network and, if there is no communication between said printing apparatus and said information

Art Unit: 3621

distributing apparatus for a predetermined period of time, said controlling section controls said print processing section not to execute the print processing of said literary work information (figure 15 and associated text; columns 19-22).

11. The accounting printing system according to claim 6, wherein said printing apparatus further includes an accounting information list generating section for generating and outputting a list of said literary work information (column 10-11, table 1).

13. An accounting printing method comprising: an information distributing step for distributing literary work information in a digital form and management information for controlling a print processing of said literary work information through an electronic network; and a printing step for receiving and storing said literary work information and said management information through said electronic network, and for printing said literary work information under print conditions specified in said management information (figure 4a, 15 and associated text; column 4, lines 5-50; columns 24-26).

14. The accounting printing method according to claim 13, wherein said printing step includes: a user information storing step for storing information on a user who utilizes said printing apparatus; an authentication processing step for executing authentication of a user who wants the print processing of said literary work information based on said information on said user; a controlling step for controlling the print processing of said literary work information by an authenticated user based on said information on said user and said management information;

and a print processing step for printing said literary work information in accordance with a command from said controlling step (figure 15 and associated text)

15. The accounting printing method according to claim 13, wherein said management information controls upper and lower limit numbers of pages to be printed of said literary work information (columns 10-11).

16. The accounting printing method according to claim 14, wherein said printing step further includes an aggregating step for aggregating and outputting a printing fee of said literary work information (figure 18 and associated text; columns 24-26).

17. The accounting printing method according to claim 14, wherein said printing step further includes an accounting information list generating step for generating and outputting a list of said literary work information (column 10-11, table 1).

18. A computer-readable storage medium storing an accounting printing program which can be executed by a computer, said accounting printing program comprising: information distributing processing for distributing literary work information in a digital form and management information for controlling a print processing of said literary work through an electronic network; and print processing for receiving and storing said literary work information and said management information through said electronic network, and for printing said literary work

information under print conditions specified in said management information (figure 4a, 15 and associated text; column 4, lines 5-50; columns 24-26).

19. The computer-readable storage medium storing an accounting-printing program according to claim 18, wherein said print processing includes: a user information storing section for storing information on a user who utilizes said printing apparatus (figure 13 and associated text); an authentication processing section for executing authentication of a user who wants the print processing of said literary work information based on said information on said user (figures 16-17 and associated text); a controlling section for controlling the print processing of said literary work information by an authenticated user based on said information on said user and said management information (figures 4a-b and associated text); and a print processing section for printing said literary work information in accordance with a command from said controlling section (figure 14 and 18 and associated text).

20. The computer-readable storage medium storing an accounting printing program according to claim 18, wherein said management information controls upper and lower limit numbers of pages to be printed of said literary work information (columns 10-11).

21. The computer-readable storage medium storing an accounting printing program according to claim 19, wherein said print processing further includes aggregating processing for aggregating and outputting a printing fee of said literary work information (figure 18 and associated text; columns 24-26).

22. The computer-readable storage medium storing an accounting printing program according to claim 19, wherein said print processing further includes accounting information list processing for generating and outputting a list of said literary work information (column 10-11, table 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al, U.S. Patent 6,236,971 B1.

As per claim 12, Stefik discloses an accounting printing system for printing literary work information in a digital form, wherein said literary work information includes management information for controlling a print processing of said literary work information, and said literary work information is printed based under print conditions specified in said management information (figure 15 and associated text; column 4, lines 5-50; columns 24-26). Stefik fails to explicitly teach the use of stencil printing apparatus. Official notice is taken that a stencil printing apparatus is an old and well-known type of commercial printing device used in the printing industry. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement Stefik's system for controlling and distribution of digital data

wherein a stencil printing apparatus is used for custom precise and electronic commercial printing purposes.

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb
December 9, 2003


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 0010